



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/228,954 01/12/99 BURNS

A 971286A

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IM22/0702

EXAMINER

JUSKA, C

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Advisory Action

Application No.  
09/228,954

Applicant(s)  
Burns, Jr. et al.

Examiner  
Cheryl Juska

Art Unit  
1771



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED May 18, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
  - (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b) ☐ they raise the issue of new matter. (See NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The new limitation to a plasticizer has not been previously examined.

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
The arguments are based upon a non-entered amendment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 23-34, 58-61, and 63-68 (with claims 35-57 and 62 being withdrawn)
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: See attachment.

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## OFFICE ACTION

### *Response to Request for Withdrawal of Finality*

1. Applicant's arguments for the withdrawal of finality of the last Office Action, submitted as Paper No. 14 on May 18, 2001, has been entered. Said arguments have been fully considered but are found unpersuasive. Applicant traverses said finality by asserting (1) the Examiner's improper use of a new reference to support a 102 rejection and (2) the Examiner's altered position with respect to claim interpretation.
2. With regard to the first point, it is asserted that two new references were employed in response to Applicant's traversal of the Examiner's inherency arguments (Remarks in Amendment A, Paper No. 9). MPEP 2131.01, *Multiple Reference 35 U.S.C. 102 Rejections* states the following:

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure;"
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

### III. TO SHOW THAT A CHARACTERISTIC NOT DISCLOSED IN THE REFERENCE IS INHERENT

*Extra Reference or Evidence Can Be Used To Show an Inherent Characteristic of the Thing Taught by the Primary Reference*

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

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recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)  
Thus, according to MPEP 2131.01, the Examiner's reliance upon the cited *Carpet Substrates* and *Principles of Polymer Systems* references is proper in that said references are employed to show that a characteristic not disclosed in the 102 reference is inherent.

3. With regard to the second point, it is asserted that the new rejection of claims 58, 59, and 61 as being anticipated by the cited Ervin and French patents (section 6 of Final Rejection Office Action) was a direct result of Applicant's amendment to claim 58. MPEP 706.07(a) *Final Rejection, When Proper on Second Action* states the following:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

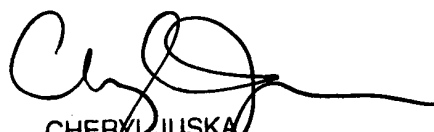
The new rejection of said claims was necessitated by Applicant's amendment to the claims. Therefore, the finality of the Office Action is proper. The change in interpretation of said claims with respect to the new art is irrelevant to the issue of finality.

#### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

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reached at (703) 308-2414. The official fax number for this TC 1700 is (703) 872-9310 and, for  
After Final communications, (703) 872-9311.



CHERYL JUSKA  
PATENT EXAMINER

cj

July 1, 2001